

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: **10/743,178**
Applicant: **Cheng, Li-Ming**
Filing Date: **December 23, 2003**
Art Unit: **3634**
Examiner: **Johnson, Blair**
Attorney Docket No.: **21406-001**

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW
REASONS FOR REVIEW**

Sir:

This paper responds to the Final Office Action dated September 25, 2007, and is a follow-up to the Response to Final Office Action (with After Finals Amendment) submitted October 31, 2007. No extension of time is believed to be necessary. If any necessary fee for this paper is not submitted via EFS, the Office is authorized to charge the necessary fee to Deposit Account No. 50-3856.

A Notice of Appeal (PTO/SB/31), necessary fees, and a Pre-Appeal Brief Request for Review (PTO/SB/33) accompany this paper.

The following are reasons for Pre-Appeal Brief Review:

ARGUMENT

The Final Office Action dated September 25, 2007 rejected claims 50-55, 58-65 and 67-73; claims 56, 57, and 66 were objected to. The applicant disagrees with all rejections.

The following prior submissions are referred to in this paper:

Response to Final Office Action, filed Oct. 31, 2007, hereinafter Paper number 1

Final Office Action, dated September 25, 2007, hereinafter Paper number 2

Supplemental Response, filed July 24, 2007, hereinafter Paper number 3
Declaration by Jerry Zerg, filed July 17, 2007, hereinafter Paper number 4
Supplemental Response, filed May 30, 2007, hereinafter Paper number 5
Declaration by Crous Swart, filed April 10, 2007, hereinafter Paper number 6
Declaration by Li-Ming Cheng, filed April 10, 2007, hereinafter Paper number 7
Declaration by ChingHo Chao, filed April 10, 2007, hereinafter Paper number 8
Response to Office Action, filed April 10, 2007, hereinafter Paper number 9
Preliminary Amendment, filed December 04, 2006, hereinafter Paper number 10

**A. The Office Erroneously Required that Secondary Indicia of Non-Obviousness
Need to be Recited in the Claims**

The law does not require that the Applicant claim Secondary indicia of non-obviousness presented in a Declaration. *In re Merchant*, 197 USPQ 785. However, the Office erroneously argued (in Paper No. 2, page 3, lines 13-15 from top) that the desirable characteristics indicated in Mr. Zerg's Declaration is not persuasive because such characteristics are not claimed and would be difficult to claim (also see Applicant's argument in paper No. 1, page 11, second paragraph).

**B. The Office Erroneously Argued that a Design that is now in Widespread Use is
Further Evidence of Obviousness of such Design**

The obviousness test is to consider whether it would have been obvious "at the time the invention was made," not whether a motivation proposed by the Office has led to a design that is "now in widespread use." (also see Applicant's argument in paper no. 1, page 11, third paragraph).

The Office is reminded to consider the totality of the evidence presented. There is sufficient secondary indicia of non-obviousness in the record, the Office cannot ignore these evidence (as presented by Declarations and in arguments of record) by merely definitively stating (without factual support) that a proposed motivation "is exactly what led to the now widespread use of [the design]." The Office must address secondary indicia of non-obviousness presented by the applicant.

In addition, what is now in widespread use says nothing about whether it would have been obvious at the time the invention was made. Although the claims recite a design that is now in widespread use, evidence in the record support that such design would not have been obvious at the time the invention was made (also see Applicant's argument in paper No. 1, page 11, third paragraph).

C. The Office Erroneously Discredited Teaching Away references and Combinations that Would Have Destroyed a Primary Reference

The Office erroneously stated that the combination of Gertzson and Kuhar would NOT have destroyed Gertzson, when the applicant provided evidence of teaching away, and evidentiary support for the finding that the combination of Gertzson and Kuhar would have destroyed the Gertzson reference (also see Paper No. 1, page 11, last paragraph, and first and second paragraphs on page 12). The Office also erred in not considering and not addressing these specific evidence and arguments in particular (Paper No. 3, page 2, first four bullet points) (Paper No. 9, page 8, top four paragraphs) (Paper No. 9, page 9, second paragraph) (Paper No. 9, page 9, last paragraph; page 10, third paragraph) (see Paper No. 7, page 3, point 13) (Paper No. 10, page 9, third and fourth paragraphs; page 10, first paragraph).

D. The Office Erroneously Discredited Evidence of Commercial Success

The Applicant has provided evidence of commercial success with sufficient nexus (see Paper No. 1, page 12, third paragraph) (Paper No. 6, points 4-10, 16, and 19) (Paper No. 7, points 16, 17).

E. The Office Erroneously Discredited Evidence of Unexpected Result and Teaching Away as "Hindsight"

In response to the Declarations filed (from Mr. Chao and Mr. Cheng), the Office contended that the declarant's opinions are merely hindights. The Office is respectfully reminded that those opinions are provided as evidence of unexpected results, teaching away, among other things. Those opinions are NOT provided as ultimate legal conclusions on the issue of obviousness (see also Paper No. 1, page 12, last paragraph). Therefore, the Office erred by not addressing and not considering the weigh of these secondary indicia of non-obviousness (please also see Paper No. 3, page 2, fifth bullet point) (Paper No. 4, points 12-19, and 24) (Paper

No. 9, page 10, last paragraph; page 11 top 3 paragraphs) (Paper No. 8, point 5) (Paper No. 9, Page 13, first bullet point) (Paper No. 7, point 15).

F. The Office Erred in Finding that “to Entrain the cords around rotors numerous times merely duplicates the arrangement in Gertzson,” When Evidence Strong Suggest Otherwise

Regarding claims 70-73, evidence in the record strongly support a finding that the cord arrangement as claimed is novel and non-obvious from the proposed combination of Gertzson and Kuhar. Without addressing and considering the specific arguments and evidence on this particular element of cord entrainment around rotors (Paper No. 4, points 14, 21-23) (Paper No. 9, Page 14, last paragraph; page 15, last paragraph; page 16, first paragraph), the Office simply stated that the claimed arrangement “merely duplicates the arrangement in Gertzson.

G. The Office Erred in Failing to Address Specific Arguments and Evidence Presented by the Applicant Regarding Unmet Needs, Copying of Others, and Failure of Others

The Office is reminded to consider the totality of the evidence. The Final Office Action did not address secondary indicia of non-obviousness presented by the Applicant regarding unmet needs and copying of others (see Paper No. 7, points 5, 6, 9, 10, 11, 14, 19, 21, 22, 23) (Paper No. 6, page 2, point 11) (Paper No. 8, point 4) (Paper No. 10, page 12, points 3 and 4).

H. The Office Erred in Essentially Forcing a Comparison of the Invention with Itself

Please see Paper No. 3, page 3, third paragraph.

I. The Conclusion of Unpatentability was not based on the Totality of the Evidence

In response to the four Declarations the Applicant submitted under 37 CFR 1.132 (Paper numbers 3, 5, 6, 7), the Office erroneously continued its obviousness rejection by attacking each Declaration individually (see the remarks section of Paper No. 2) in a piecemeal fashion. The Office is respectfully reminded that when an applicant submits evidence traversing a rejection, the examiner must make a fresh consideration of all of the evidence (including evidence cited by the examiner and the evidence submitted by the applicant). It is insufficient to state that the

affidavit is insufficient to rebut the prima facie case. Rather, any conclusion of unpatentability must be based upon the totality of the evidence. *In re Piasecki*, 223 USPQ 785 (Fed. Cir. 1984); *In re Semaker*, 217 USPQ 1 (Fed. Cir. 1983). MPEP 716.01(b). (also see Applicant's argument in paper no. 1, page 10, last paragraph). As discussed above, the applicant has submitted secondary indicia of non-obviousness, including evidence of unexpected result, teaching away, commercial success, copying of others, failure of others, unmet needs, among others. The Office must consider all of the evidence as a whole, against cited prior art references (see also Paper No. 9, page 12, third and fourth paragraphs; page 13, first paragraph).

CONCLUSION

As required by the USPTO, This Reason for Request is no more than five pages, and concisely points out errors in the Examiner's rejections and the Examiner's omissions of essential elements needed for proper rejection by referring to arguments already of record. By referring to Paper No. in this request, the Applicant does not intend to limit supporting evidence to what's specifically referred to herein, and the paper Nos. specifically referred to are only partial examples of arguments of record. The Applicant respectfully requests the Panel to consider all arguments of the record.

Respectfully submitted,

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